



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Leonard I. Zon and Adriana Donovan

Application No.: 09/715,927

Group Art Unit: 1647

Filed: November 17, 2000

Examiner: S. Wegert

For: Ferroportin1 Nucleic Acids and Proteins

| CERTIFICATE OF MAILING  |                      |
|---|----------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202 |                      |
| on <u>5/14/02</u>   | <u>Annie Demirel</u> |
| Date  | Signature            |
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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents  
P.O. Box 2327  
Arlington, VA 22202

Sir:

Responsive to the Restriction Requirement dated January 14, 2002, the claims of Group I (Claims 1-72) drawn to nucleic acids encoding a transporter polypeptide, complementary nucleic acids, vectors, host cells and methods of producing polypeptides recombinantly are elected for prosecution. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

An extension of time to respond to the Restriction Requirement is respectfully requested. A Petition for an Extension of Time and the appropriate fee are being filed concurrently. Also being submitted at this time is a Preliminary Amendment.

In response to the election of a group of sequences, Applicants elect item c) from groups a)-f) as recited on page 3 of the Restriction Requirement. Item c) refers to SEQ ID NO:5 and 7.

Those claims that read on the elected sequence group are Claims 46-54, Claims 56 and 57, Claims 59-63 and Claims 65-72, considering Claims 47 and 67-69 as amended in the Preliminary Amendment also being filed at this time.

The requirement is being traversed for the reasons set forth in detail below.

The claims of Groups V and VII (Claims 120-121, 123 and 128) are all drawn to a method of identifying an inhibitor of iron export. Claim 123 depends from Claim 121 by adding additional steps to the method. For a method claim, the examination and search for the claim will depend on the steps of the method, entirely independent of the compound identified. A search covering the method with the greater number of steps, as in dependent Claim 123, will necessarily cover the independent claim with fewer steps. Therefore, the search of independent Claim 121 in Group V will be covered by the search of dependent Claim 123 in Group VII, which has a greater number of steps. There is no extra burden of search by combining the two groups.

The claims of Groups IX and XI (Claims 125, 127, 129 and 130) are drawn to methods of identifying an enhancer of iron export. Claim 127 depends on Claim 125, adding more steps to the underlying method of Claim 125. Claim 130 depends from Claim 129, adding more steps to the method of Claim 129. The classification for Groups IX and XI depends on the steps of the method, not the end product. The methods described in the claims of Groups IX and XI are closely related and the search for prior art relating to Claims 127 and 130 will yield prior art relating to Claims 125 and 129. Therefore, separate prior art searches will not be necessary for these two groups.

The claim of Group XII (Claim 130) has been classified as being in both Group XI and Group XII. Claim 130 is not drawn to an enhancer of iron transport, as the Examiner recites on page 3 of the Restriction Requirement. Claim 130 is drawn to a method of identifying an enhancer of iron export, and depends on Claim 129, adding more steps to the method. Applying reasoning similar to that applied above, it is most logical to include Claim 130 with Claim 129 because Claim 130 adds more steps to the method of Claim 129. A prior art search covering the scope of Claim 130 will include the steps of Claim 129 and would therefore be sufficient.

Applicants respectfully request that the Examiner reconsider the grouping of the claims presented in the Office Action of January 14, 2002. Applicants propose that Groups V and VII be combined, Groups IX and XI be combined and Group XII be eliminated to form the following new Groups of claims:

| <u>New Group</u> | <u>Old Group</u> |
|------------------|------------------|
| I                | I                |
| II               | II               |
| III              | III              |
| IV               | IV               |
| V                | V + VII          |
| VI               | VI               |
| VII              | VIII             |
| VIII             | IX + XI          |
| IX               | X                |
| X                | XIII             |

In addition, Applicants traverse the election of a group of sequences as set forth on page 3 of the Restriction Requirement of January 14, 2002

According to *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996), the Commissioner determined that normally, ten nucleotide sequences constitute a reasonable number for examination purposes. This guideline was made in the interest of aiding the biotechnology industry, without imposing an undue burden on the Patent Office. Applicants believe that the prior art search and examination of Claims 1-72, considering only the four polynucleotides (SEQ ID NO:1, SEQ ID NO:3, SEQ ID NO:5 and SEQ ID NO:7) and the three polypeptides encoded by the polynucleotides (SEQ ID NO:2, SEQ ID NO:4 and SEQ ID NO:6) together, would be in keeping with these interests voiced by the Commissioner in 1996. Applicants therefore request that the election of a group sequences as it may apply to Claims 1-72 be withdrawn.

If the above request to withdraw the election of a group of sequences is not withdrawn, Applicants make this alternative request. Applicants request that the claims of Group I which are drawn to nucleic acids described, in whole or in part, in terms of encoding a polypeptide comprising or consisting of all or a portion of SEQ ID NO:6 be examined initially along with those claims containing "SEQ ID NO:5" or "SEQ ID NO:7."

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An "Attachment for PTO-948" was received with the Restriction Requirement. However, no Form PTO-948 was received with the "Attachment." Applicants assume that the "Attachment for PTO-948" was sent in error by the United States Patent and Trademark Office.

Respectfully submitted,

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Dated: *May 14, 2002*